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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Paul M. Yates	)Examiner
Serial No.:	09/728,455	)Vargot, M.
Filed:	12/01/2000	)Group Art
For:	CUSHION WITH LUBRICATED PARTICULATES	)1732

January 2003

BRIEF ON APPEAL

Commissioner of Patents & Trademarks
Washington, DC 20231

Dear Sir:

This appeal is taken from a final rejection of claims 1-5 and 21-34 of the hereinabove referenced Patent Application in a final Office Action mailed August 28, 2002; Oral hearing is waived.

REAL PARTY OF INTEREST

The present application is presently not assigned.

RELATED APPEALS AND INTERFERENCES

A division Serial No. 10/323,081 of the subject U.S. Patent Application is pending.

STATUS OF CLAIMS

Claims (See Appendix A)	Status
1-5 and 22-34	Rejected under 15 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,954,303 to Wolf, et al.

STATUS OF POST FINAL AMENDMENT

No post find amendment have been filed.

CONCISE SUMMARY OF THE INVENTION

The present invention provides for a cushion having a cover and a core, the core includes a volume of individual separate particulates and a liquid, such as oil, disposed between the particulates for enabling lubricated movement of the particulates within the core in response to an outside force applied to the cover. This combination provides the "feel" of a gel cushion. That is, the core does not displace like a liquid but has the elastic feel similar to a gel.

ISSUE PRESENTED FOR REVIEW

The Examiner has rejected claims 1-5 and 22-34 as being anticipated by U.S. Patent 5,954,303 to Wolf, et al.

GROUPING OF CONTESTED CLAIMS

Claims 1-5 and 22-34 fall as a single group of contested claims.

ARGUMENT

REJECTION UNDER 35 U.S.C. 102(b)

The Examiner has rejected claims 1-5 and 22-34 under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,954,303 to Wolf, et al. In this rejection the Examiner states that Wolf, et al. discloses a cover (32) that is stretched and can be molded to a selected contour. The cover prevents leakage and has a backing (16). The Examiner alleges that disposed within the cover there is a core with a volume separate, open self-foam particles. The Examiner refers to Figure 2 and column 4, lines 56-67 with regard to a disclosure of the alleged particles.

The Examiner further alleges that the particulates are compressible and a liquid can be partially disposed (through absorption) therein.

The Examiner further states that there is a gel 34 between the particulates which can enable lubricated movement of the particulates with respect to one another in response to an outside force applied to the cover.

The applicant respectfully traverses this rejection by the Examiner and submits the following arguments:

It must be noted that the unidentified "particulates" shown in the drawings of Wolf, et al., particularly Figure 2 are not described in the specification nor referred to in any manner whatsoever. With specific reference to column 4, line 54 Wolf states as follows:

"Although it is preferred that a layer of gel be used in the wrist rest pad assembly 12, the elongate pad 30 could instead comprise a different support material, such as an open-cell foam, a closed-cell foam, liquid or particulate filled bags or pouches, wood, plastic, metal, or any other material suitable for supporting the wrist of a user. The support material may also be a combination of these or other suitable materials, depending upon the preferences of the manufacture and the user."

The Applicants submits that this is a non-enabling disclosure. It has been stated that even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it were not enabling. In re Donohue 226 USPQ 619,621 (CAFC 1985), in re Borst, 45 USPQ 554,557 (CCPA 1965), cert. Denied, 148 USPQ 771 (1966).

It is well settled that prior art under 35 USC 102(b) must sufficiently described the claimed invention to have placed the public in possession of it. In re Sasse, 207 USPQ 107, 111 (CCPA 1980); In re Samour, 197 USPQ 4; Redding and Bates Construction Company v. Baker Energy Resources Corp. 223 USPQ 1168-1173 (Fed. Cir. 1984).

Such possession is effected if one of ordinary skill in the artwork could have combined the publication's, description of the invention with his own knowledge to make the claimed invention. In re LeGrice, 133 USPQ 365, 373 (CCPA 1962).

The statement in Wolf that "The support material may also be a combination of these or other suitable materials..." is a mere "germ" of an idea. However, as set forth in Genentech, Inc. v. Novo Nordisk, A/S, 42 USPQ 2d 1001 (Fed. Cir. 1997) an enabling disclosure is not "tossing out the mere germ of an idea" but the provision of "reasonable detail..." in order to enable members of the public to understand and carry out the invention.

Clearly, the Wolf, et al. reference intends to encompass every material in the world which is suitable for supporting wrists of a user and any combination of all materials that exist.

The Applicants submits that for prior art to be pertinent it must be enabling—it must place the public in possession of the invention. Items which do not sufficiently teach and skill artists in how to make, use and practice the invention are not prior art to the invention. Akzo N. V. Vu.S. Int'l Trade Commission 1 USPQ 1241, 1245 (Fed. Cir. 1986); in re Hall, 228 USPQ 453, 455 (Fed. Cir. 1986) further stating that in order to be prior art, the prior art referenced must teach the claimed invention without further research or experimentation. See also in re Pyne 203 USPQ 245, 255 (CCPA 1979) and Fizer,

Inc. v. International Rectifier Corp. 207 USPQ 397, 425 (Dist. Ct. C.D. California 1980).

The Applicants submit that the Wolf, et al. reference does not disclose a core comprising a volume of separate particulates in a oil disposed between the particles for enabling lubricated movement of the particles with respect to one another in response to an outside force applied to a cover over the core. (See claim 1)

The Wolf, et al. reference, in addition to listing all possible materials that could be used for supporting the wrist of a user further states that a combination of this infinite number of materials can be utilized depending upon the preference of the manufacturer. This disclosure, if assumed enabling, would anticipate every wrist pad made, or to be made.

The Applicants submits that this disclosure does not place the public in possession of the present invention and does not sufficiently teach a skilled artisan how to make, use and practice the invention. Thus it is not prior art to the invention. Ethyl molded products Co. v. Betts Package, Inc. 9 USPQ 2d 1001, 1030 (E.D. 1988).

The Applicant further argues that the Wolf, et al. reference also would not support a rejection under 35 USC section 103 on the same arguments hereinabove provided.

The Examiner in responding to the Applicant's earlier arguments also relies on U.S. 3,676,387 to Lindof. While not relied for teaching particulates the Applicant would

like to introduce the fact that the Lindof reference does not teach any particulates and, in fact, the paragraph cited by the Examiner, namely in column 3, beginning with line 64 states:

"A mixture of 5 parts 'Nujol' Brand U.S.P. Mineral oil and one part styrene-isoprene-styrene block equal polymer ("Kraton 107" were heated to approximately 300°F. and agitated vigorously until the polymer appeared virtually dissolved". (Emphasis added)

Accordingly, the Lindof reference has no value whatsoever with regard to anticipating or making obvious claimed the present invention, which includes a core comprising a volume of separate particulates and an oil disposed between the particulates for enabling lubricated movement of the particulates.

In view of the arguments hereinabove set forth it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reconsideration and allowance are respectively requested.

Respectfully submitted,

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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, D.C. 20231, ON

June 19, 2003

6/19/03
(DATE SIGNED)

WALTER A. HACKLER
REG. NO. 27,792